



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/194,112	11/23/98	ONUKI	229-532PCT

002292 QM12/0807
BIRCH STEWART KOLASCH & BIRCH
P O BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

BLAU, S

ART UNIT PAPER NUMBER

3711

9

DATE MAILED: 08/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/194,112

Applicant(s)

Onuki

Examiner

Stephen Blau

Group Art Unit

3711



☒ Responsive to communication(s) filed on May 15, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

SIB
8/15/00

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peker.

Peker discloses a golf club head having a hitting face formed of a metallic amorphous metal, an amorphous alloy of zirconium base, Ni, Al, Cu, Hf, tensile strength 1.9 GPa (194 kgf/mm²) (Col. 4 Lns. 12-43), a material meeting the formula $M(a)X(b)$ with $65 \leq a \leq 100$ and $0 \leq b \leq 35$ in the form of $M(\text{Zr/Ti/Be/Cu/Ni})$ of 100 (Col. 4, Lns. 13-16), a material meeting the formula $\text{Zr}(c)M(d)X(e)$ with $20 \leq c \leq 80$, $20 \leq d \leq 80$, and $0 \leq e \leq 35$ in the form of Zr of 41.2, $M(\text{Ti/Be/Cu/Ni})$ of 58.8, and $X(\text{Hf})$ of 0 (Col. 4, Lns. 23-27), and material meeting the formula $\text{Zr}(c)M(d)X(e)$ with $50 \leq c \leq 75$, $25 \leq d \leq 50$, and $0 \leq e \leq 1$ in the form Zr of 60, $M(\text{Al/Ni})$ of 40 and $X(\text{Hf})$ of 0 (Col. 4, Lns. 39-43). Clearly the hitting face material has a Young's modulus and a hardness and one skilled in the art in manufacturing a hard face with mixtures of elements of Zr/Ti/Be/Cu/Ni/Hf would have selected a composition having a suitable hardness and Young's

Art Unit:

modulus in which a hardness and Young's modulus which meets the relationships in claim 1 and 5, a Young's modulus of 5,000 to 16,000 kgf/mm² and a Vickers hardness of 400 to 1,000 HV are included.

The difference between the claims and Peker is that Peker does not disclose a Young's modulus of 5,000 to 16,000 kgf/mm², a Vickers hardness of 400 to 1,000 HV, a relationship between Young's modulus and tensile strength as defined by claim 1 and a relationship of Young' modulus and hardness as defined by claim 5.

It would have been obvious to modify the face of Peker to have a Young's modulus as defined by the claims in order to have face which has a sufficient flex for a specific golfer. In addition, it would have been obvious to have a hardness as defined by the claims in order to have a face which maximizes the transfer of energy to a ball at impact.

Drawings

3. The drawings of this application have not been reviewed by the Draftsman. Upon allowance of this case the drawings will be evaluated under 37 CFR 1.81.

Response to Arguments

Art Unit:

4. The argument that it is improper to use the patent of Peker since Peker fails to provide adequate basis to select the properties as defined in the claims is disagreed with. Peker discloses the exact makeup of the elements as defined in the claims (Claims 14-19). Clearly the face of Peker will have a Young's modulus and hardness. Since the material of Peker is the same as the material claimed by the applicant in composition, it would be obvious to have the face of Peker having the same properties as claimed.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

Art Unit:

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Jeanette Chapman whose telephone number is (703) 308-1310. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

slb/ 5 August 2000



JEANETTE CHAPMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700